

UNITED STATES COURT OF APPEALS FOR THE FEDERAL COURT

JEFFREY JOVAN PHILYAW,

Appellants

v.

JOHN W. DUDAS, DIRECTOR OF THE  
UNITED STATES PATENT AND  
TRADEMARK OFFICE,

Appellee.

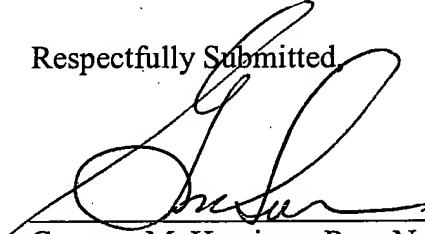
NOTICE OF APPEAL

Jeffrey Jovan Philyaw hereby petitions/appeals the court for review of the Decision on Appeal, Appeal No. 2007-1745, of the Board of Patent Appeals and Interferences, dated December 11, 2007, which affirmed the Examiner's final rejection of Claims 1-16, 18-33 and 35 of U.S. Patent Application Serial No. 09/614,937.

Respectfully Submitted

Date

2/1/08

  
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**CERTIFICATE OF TRANSMISSION (37 C.F.R. § 1.8(A))**

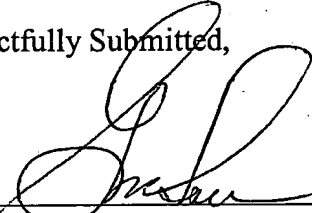
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFFRY JOVAN PHILYAW

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Appeal 2007-1745  
Application 09/614,937  
Technology Center 2100

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Decided: DATE, 2007

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*Before:* ALLEN R. MACDONALD, JAY P. LUCAS, and ST. JOHN  
COURTENAY III, *Administrative Patent Judges.*

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellant appeals a Final Rejection of claims 1-16, 18-33, and 35 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant invented a method and apparatus for extracting a unique code from a triggering device and retrieving and presenting a web page associated with the unique code. (Spec. 45:2-8.)

Claim 1 is exemplary and is reproduced below:

1. A method of displaying a web page to a user, comprising the steps of:

providing a portable triggering device having a unique code stored therein;

extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system, the activation system disposed on a network and physically separate from the triggering device;

retrieving location information associated with the unique code from a database, the location information corresponding to a location of the web page on a remote location disposed on the network;

in response to retrieving the location information, automatically connecting the activation system to the remote location; and

presenting the web page corresponding to the location information of the remote location to the user via the activation system.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hudetz et al.	US 5,978,773	Nov. 2, 1999
Nelson, Jr.	US 6,297,727 B1	Oct. 2, 2001
Russell et al.	US 5,095,248	May 18, 1999
Wellner	US 5,640,193	Jun. 17, 1997
Buckley et al.	US 6,446,871 B1	Sep. 10, 2002
Schmitt et al.	US 5,903,225	May 11, 1999

Claims 1-12, 16,<sup>1</sup> 18-30, 33, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Hudetz, Nelson, and Russell.

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<sup>1</sup> We note that the summary of the rejections in the Answer at page 3 states claim 17 is rejected over the combination of teachings of Hudetz, Nelson, and Russell but claim 17 is cancelled.

Claims 13-15 and 31-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Hudetz, Nelson, Russell, and Wellner.

Claims 1-4, 8-11, 16, 18-22, 24, 26, 28-29, 33, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Buckley and Schmitt.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

We AFFIRM.

#### ISSUE

Has Appellant shown that the Examiner erred in finding that claims 1-16, 18-33, and 35 are unpatentable under 35 U.S.C. § 103(a)?

#### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *Hudetz*

1. Hudetz teaches an article 48 having a symbol 46. (FIG. 2.) Hudetz teaches that article 48 can be "all types of items" and gives examples of cards, consumer products, newspaper, books, coupons, fliers, and advertisements. (Col. 10, ll. 3-10.) Symbol 46 is a Uniform Product Code ("UPC") bar code. (Col. 5, ll. 25-26.)

2. Hudetz teaches that an input device 44 reads the symbol 46 from article 48 by, for example, scanning the symbol 46. (Col. 5, ll. 24-25.) One example of an input device 44 is a wand-style bar code reader. (*Id.*) Input device 44 reads the symbol 44 and transfers the symbol to local host 28 via I/O port 38. (FIG. 1 and Col. 5, ll. 22-23.)
3. Hudetz teaches that input device 44 is physically separate from article 48 and input device 44 reads the symbol 46 when input device 44 is proximate to article 48. (FIG. 2.)
4. Hudetz teaches that input device 44 is coupled to local host 28 via I/O port 38. (FIG. 1 and Col. 5, ll. 22-23.) Local host 28 includes a modem 36 and communicates with a service provider 22 via the Internet network. (FIG. 1 and Col. 5, ll. 36-38.)
5. Hudetz teaches that remote nodes 24 and 26 act as servers to local host 28. (Col. 5, ll. 51-52.) Remote nodes 24 and 26 are remote from local host 28 and are accessible to local host 28 via the Internet network. (Col. 5, ll. 61-64.) Remote nodes 24 and 26 store web sites. To access a website, local host 28 requests the web sites by transmitting a URL. (Col. 5, ll. 55-64.) Websites include web pages. (Col. 2, ll. 46-47.)
6. Hudetz teaches that service provider 22 stores a database 60 that includes UPC number read from symbol 46 in fields 70 and 72 and an associated URL in field 74. (Col. 7, ll. 2-13 and FIG. 4.) The URL is an address location of a website located on remote nodes 24 and 26, which are remote from local node 28. (Col. 5, ll. 48-64.)
7. Hudetz teaches that in response to reading of the UPC number by input device 44, a Web server resident on local service provider 22 looks up

the UPC number in database 60. (Col. 8, ll. 43-46.) Database 60 retrieves and transmits to local host 28 all records having a field that matches the UPC number. (Col. 8, ll. 47-49 and Col. 9, ll. 5-10.)

8. Hudetz teaches that the browser software located on local host computer 28 automatically loads the retrieved URL and displays the web page addressed by the URL. (Col. 9, ll. 60-62.)

*Nelson*

9. Nelson teaches a transponder that includes a memory and the memory stores a unique identification code. (Col. 5, ll. 42-44; Col. 6, ll. 8-13; and Col. 10, ll. 48-50.)
10. Nelson teaches that the transponder is a small size (col. 7, ll. 6-7) and that an assembly with the transponder can be card sized (col. 4, ll. 33-50 and Figs. 1a and 1b).
11. Nelson teaches that the transponder 22, including the memory that stores the unique identification code, is encompassed within a combination of a support 24 and a protective cover 26. (Col. 4, ll. 51-54 and FIG. 2.)
12. Nelson teaches that an interrogator unit 36 transmits an interrogation signal 38 to transponder 34 and, when transponder 34 is close enough to interrogator unit 36 to receive the signal, transponder 34 processes the signal and transmits a response signal 40 back to the interrogator unit 36 containing an identification code. (Col. 3, ll. 10-13 and Col. 6, ll. 16-25.)

13. Nelson teaches that records can be maintained using computerized data base records based on identifications received by interrogation unit 36. (Col. 10, ll. 39-50.)

*Russell*

14. Russell teaches a system for accessing web pages stored on a network by scanning code symbols using a bar code symbol reader 3A. (Col. 7, ll. 31-52.)
15. Russell teaches that bar code symbol reader 3A reads a bar code symbol and transfers the symbol to Internet terminal 3B. (Col. 8, ll. 1-6.)
16. Russell teaches that the Internet terminal 3B automatically accesses and displays the web page associated with the bar code symbol provided by bar code symbol reader 3A. (Title, Abstract ll. 4-12, and Col. 2, l. 46 - Col. 3, l. 26.)

*Wellner*

17. Wellner teaches a scanner pen 11 that reads marks on a scanned object and transmits a decoded output to a user interface 15 over radio link 12. (Col. 2, ll. 43-54 and FIG. 1.)
18. Wellner teaches that scanner pen 11 includes a memory 404 that stores a scanner pen identification code and transmits the scanner pen identification code to the interface 15. (Col. 2, l. 66 - Col. 3, l. 14.)

*Buckley*

19. Buckley teaches a bar code is placed in an article or advertisement. (Col. 4, ll. 41-43.)
20. Buckley teaches that a code reader contained in a writing implement 16 reads and stores the bar code. (Col. 4, ll. 49-52 and Col. 5, l. 42.)



21. Buckley teaches that the writing implement 16 is separated from a data well 26 and that to transfer data from writing implement 16 to data well 26, the data transfer end 20 of the writing implement 16 is inserted into a data well 26. (Col. 5, ll. 43-47.) Signals representing the scanned code are transferred to computer 28 through cable 30. (*Id.*)
22. Buckley teaches that the writing implement 16 communicates with a personal computer using a wireless link. (Col. 5, ll. 48-52.) Computer 28 accesses a network by connecting to an Internet server. (Col. 8, ll. 60-66.)
23. Buckley teaches that computer 28 receives codes from the data well and accesses a database contained at a remote location, using the Internet, to obtain an Internet site address corresponding to the code. (Col. 4, l. 64- Col. 5, l. 8 and Col. 8, ll. 60-63.)
24. Buckley teaches that accessing the database provides an Internet home page URL address and the computer system connects to the Internet site corresponding to the URL address using a web browser. (FIG. 9; Col. 3, ll. 31-41; Col. 8, l. 64 – Col. 9, l. 7; and Col. 12, ll. 5-14.)

*Schmitt*

25. Schmitt teaches an access triggering device that is capable of transmitting an authorization signal associated with the access triggering device. (Col. 2, ll. 51-55.)
26. Schmitt teaches that the access triggering device is carried by a person. (Col. 12, l. 47.)
27. Schmitt teaches that the access triggering device is a passive transponder and that a transponder powering means powers the passive

transponder when positioned in proximity to the passive transponder. (Col. 3, ll. 7-11; Col. 12, ll. 34-55; and Col. 13, ll. 3-10.) The passive transponder responds to the powering by transmitting the authorization signal to a receiver. (Col. 12, ll. 34-46.)

28. Schmitt teaches that an access controller 210 (that wirelessly interrogates an access triggering device 207) is coupled to a computer 201 through connection 252. (Fig. 14 and Col. 12, l. 34 – Col. 13, l. 15.)

#### PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383

U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18. "If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." *KSR*, 127 S. Ct. at 1734.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248 [(1850)]." *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a

processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that "[a]n obviousness [determination] is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)).

Although the combination of prior art references lacked a "reader" to automatically identify the book inserted in the device, the Federal Circuit found no error in the District Court's determination that readers were well known in the art at the time of the invention. *Id.* at 1162. In addition, the Court found that the reasons for adding a reader to the combination of prior art references "are the same as those for using readers in other children's toys-namely, providing an added benefit and simplified use of the toy for the child in order to increase its marketability." *Id.* at 1162. The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

#### ANALYSIS

Appellant separately alleges the patentability of independent claims 1 and 19, and dependent claims 13 and 31. Appellant has not presented any substantive arguments directed to the separate patentability of dependent claims 2-12, 16, 18, 20-30, 33, and 35, but relies instead on their arguments

for patentability of independent claims 1 and 19. Appellant has not presented any substantive arguments directed to the separate patentability of dependent claims 14-15 and 32, but relies instead on their arguments for patentability of independent claims 13 and 31. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claims. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Claims 1-12, 16, 18-30, 33, and 35 stand rejected over the combined teachings of Hudetz, Nelson, and Russell. Because Appellant only alleges that the Examiner erred in rejecting claims 1 and 19 (Br. 7-17), and because claims 1 and 19 recite similar limitations, we select claim 1 as the sole claim from which to decide the appeal of all the claims in this group.

Claims 13-15 and 31-32 stand rejected over the combined teachings of Hudetz, Nelson, Russell, and Wellner. Because Appellant only alleges that the Examiner erred in rejecting claims 13 and 31 (Br. 22-25), and because claims 13 and 31 recite similar limitations, we select claim 13 as the sole claim from which to decide the appeal of all the claims in this group.

The Examiner has also rejected claims 1-4, 8-11, 16, 18-22, 24, 26, 28-29, 33, and 35 as being obvious over the teachings of Buckley and Schmitt. Because Appellant only alleges that the Examiner erred in rejecting claims 1 and 19 (Br. 17-22), and because claims 1 and 19 recite similar limitations, we select claim 1 as the sole claim from which to decide the appeal of all the claims in this group.

35 U.S.C. § 103(a)

We find Appellant has not shown that the Examiner erred in rejecting claims 1-16, 18-33, and 35 under 35 U.S.C. § 103(a).

- A. Appellant has not shown that the Examiner erred in rejecting claim 1 over Hudetz, Nelson, and Russell

We find that there is reason to combine the teachings and suggestions of Hudetz, Nelson, and Russell and such combination teaches all elements of claim 1. First, we support our finding that the Appellant has not shown that the Examiner erred in finding that the combined teachings of Hudetz, Nelson, and Russell teach all elements of claim 1. Next, we support our finding that the Appellant has not shown that the Examiner erred by combining of teachings of Hudetz, Nelson, and Russell.

1. The cited references teach all elements of claim 1

Claim 1 requires a portable triggering device having a unique code stored therein. The Examiner relies on Nelson to teach the required portion of claim 1. (Ans. 4 and 15.) However, Appellant alleges that Hudetz, rather than Nelson, does not teach such requirement of claim 1 and alleges the combination of teachings of Hudetz with Nelson is improper. (Br. 7-15.)

Because Appellant does not allege that the Examiner erred in finding that Nelson teaches the element of a portable triggering device having a

unique code stored therein (Br. 12-15), Appellant has not met the burden of showing that the Examiner erred. Moreover, based upon our review of the record, we find that Nelson teaches providing a portable triggering device having a unique code stored therein. (FF 9-13.)

Claim 1 requires extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system and that the activation system is disposed on a network and is physically separate from the triggering device. The Examiner relies on Nelson to teach the cited portion of claim 1. (Ans. 4 and 15.) The Appellant alleges that Hudetz, rather than Nelson, does not disclose an “activation system” and alleges the combination of teachings of Hudetz with Nelson is improper. (Br. 8-15.)

Because Appellant does not even allege that the Examiner erred in finding that Nelson teaches the elements of an “activation system” that extracts a unique code from a triggering device and the activation system is disposed on a network and physically separate from the triggering device, Appellant has not met the burden of showing that the Examiner erred. Nevertheless, we find the combination of Hudetz and Nelson teaches extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system and that the activation system is disposed on a network and is physically separate from the triggering device.

We begin our analysis by construing the term “activation system.” During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415

F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). Here, Appellant's Specification does not provide an explicit definition of the term "activation system." In the "Summary of Claimed Subject Matter" in the Brief, Appellant refers to reference number 2502 of Fig. 25 as an example of "triggering device" and in summarizing "activation system", Appellant refers to reference numbers 2500, 2504, and 2506 of Figs. 25 and 26, among others. (Br. 2-3.) However, reference numeral 2500 in Fig. 25 refers to an object and the Specification states that "object 2500 . . . contains a passive transponder 2502". (Spec. 45:17-18.) But, claim 1 states that the activation system is *physically separate* from the triggering device. Thus, contrary to the Appellant's allegation that the activation system includes object 2500, the activation system of claim 1 *cannot* include object 2500, otherwise the activation system would contain the triggering device and would not be physically separate from the triggering device, as required by the language of claim 1. Instead, the activation system includes transmitter 2504 and receiver 2506, which are connected to a network through PC 302. Therefore, we broadly but reasonably construe the claimed "activation system" to at least require a transmitter and receiver capable of transmitting and receiving signals to and from a triggering device.

Nelson teaches that interrogator unit 36 *transmits* an interrogation signal 38 to transponder 34 and, when transponder 34 is close enough to interrogator unit 36 to receive the signal, transponder 34 processes the signal and transmits a response signal 40 back to the interrogator unit 36 containing



an identification code so that interrogator unit 36 *receives* the response signal 40 (FF 12). Similarly, Hudetz teaches that when input device 44 is a scanner, the scanner reads a symbol 46 by *transmitting* a light towards the symbol 46 and *receiving* a light pattern from the symbol 46 (FF 1-3). Hudetz further teaches that input device 44 reads a symbol 46 and the input device 44 is coupled to a network through coupling to local host 28 (FF 1-4). Thus, we find the combination of Hudetz and Nelson teaches extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system and the activation system is disposed on a network and is physically separate from the triggering device.

Claim 1 requires retrieving location information associated with the unique code from a database and that the location information corresponds to a location of a web page on a remote location disposed on the network. The Examiner relies on Hudetz to teach this portion of claim 1. (Ans. 3.) The Appellant does not dispute the Examiner's finding. (Br. 7-17.)

Because Appellant does not allege that the Examiner erred in finding that Hudetz teaches the element of retrieving location information associated with the unique code from a database and that the location information corresponds to a location of the web page on a remote location disposed on the network, Appellant has not met the burden of showing that the Examiner erred. Moreover, based on our review of the record, we find that Hudetz teaches retrieving location information associated with the unique code from a database and that the location information corresponds to a location of the web page on a remote location disposed on the network. (FF 6 and 7.)

Claim 1 requires automatically connecting the activation system to the remote location in response to retrieving the location information. The Examiner relies on Russell to teach this portion of claim 1. (Ans. 5.) Appellant does not dispute the Examiner's finding that Russell teaches the aforementioned portion of claim 1 but instead alleges there is insufficient motivation to combine the teachings of Hudetz and Nelson with those of Russell or to modify the teachings of Hudetz and Nelson to arrive at automatically connecting the activation system to the remote location. (Br. 15-17.) Appellant also contends that Hudetz teaches away from a combination with Russell. (Br. 15-17.)

Because Appellant does not even allege that the Examiner erred in finding that Russell teaches an element of automatically connecting the activation system to the remote location in response to retrieving the location information, Appellant has not met the burden of showing that the Examiner erred. Moreover, based on our review of the record, we find that Russell teaches automatically connecting the activation system to the remote location in response to retrieving the location information. (FF 15-16.)

Claim 1 requires presenting the web page corresponding to the location information of the remote location to the user via the activation system. The Examiner relies on Hudetz to teach this cited portion of claim 1. (Ans. 4.) The Appellant does not dispute the Examiner's finding. (Br. 8-9.)

Because Appellant does not even allege that the Examiner erred in finding that Hudetz teaches an element of presenting the web page corresponding to the location information of the remote location to the user

via the activation system, Appellant has not met the burden of showing Examiner error. Moreover, based on our review of the record, we find that Hudetz teaches the cited portion of claim 1 by teaching that the browser software located on local host computer 28 automatically loads the retrieved URL and displays the web page addressed by the URL. (FF 8.)

2. The combination of teachings of the cited references is proper

We have thoroughly considered the Appellant's allegations that the Examiner erred by combining the teachings of Hudetz with the teachings of Nelson and Russell. We do not agree.

A. Nelson's passive transponder and interrogator system

We first address the substitution of Nelson's passive transponder and interrogator system in place of Hudetz's article of commerce and scanner system. The Examiner finds motivation to combine the teachings of Hudetz with those of Nelson because Hudetz suggests exploring art and/or provides a motivation to modify the teachings of Hudetz to include a portable triggering device having a unique code stored therein and use an interrogator system to extract the code and also because Hudetz and Nelson are both analogous art. (Ans. 4-5 and 16-17.) Moreover, the Examiner's proffered motivation for an artisan to have modified Hudetz to include Nelson's passive transponder is taken directly from the reference: "Hudetz goes on to suggest '[a]lternatively, a RF data collection scanner or CCD scanning system could be used.' (Hudetz, column, 12, lines 17-18)." (Ans. 14 and 17.)

Appellant alleges the combination is improper because there is no teaching or suggestion for the combination. (Br. 9-15.) Appellant also alleges there is no motivation to modify the teachings of Hudetz to arrive at a portable triggering device having a unique code stored therein. (*Id.*) Appellant further contends that Hudetz teaches away from the solution taught by Nelson. (Br. 14-15.)

We have considered Appellant's argument that Hudetz teaches away from the solution taught by Nelson, but do not agree. We agree with the Examiner that Hudetz provides a clear motivation (at column 12, lines 17-18) to incorporate Nelson's passive transponder and interrogator system in place of Hudetz's article and scanner system.

B. Automatic connection to a remote location

Next, we address incorporation of Russell's automatic connection to a remote location into Hudetz and Nelson's activation system. The Examiner finds that Hudetz suggests exploring the art of Russell and/or provides a reason to modify the combined method of Hudetz and Nelson to include automatically connecting the activation system to the remote location. (Ans. 5 and 18.) Appellant alleges that Hudetz teaches away from combination with Russell because Hudetz states several reasons why it may not be practical to include URLs in bar code symbols, whereas Russell teaches having URLs encoded in bar codes. (Br. 15-17.)

We have considered Appellant's argument that Hudetz teaches away from the solution taught by Russell, but do not agree. We find Hudetz provides a reason to incorporate Russell's automatic connection to a remote

location into Hudetz and Nelson's activation system by teaching that the browser software located on local host computer 28 automatically both loads a retrieved URL associated with a symbol and displays a web page addressed by the URL. (FF 6-8.)

### 3. CONCLUSION

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-12, 16, 18-30, 33, and 35 under 35 U.S.C. § 103(a).

#### B. Claim 13

Claim 13 requires that the activation system have an associated interface identification code. The Examiner relies on Wellner to teach such requirement of claim 13. (Ans. 8-9 and 20-21.) The Examiner finds that the combination of Wellner with Hudetz, Nelson, and Russell is proper because all of the references are in an analogous art and because "[i]t would have been obvious to one of ordinary skill in the art at the time of the in[vention] was made to modify the combined teachings of Hudetz and Nelson with the teachings of Richton [Wellner] to include a unique interface identification code in order to allow a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium (Wellner, column 1 lines 33-36) because this enables the selected electronic service transmitted from the servers to be received by the user's receiver." (Answer 9.)

Appellant does not dispute the Examiner's finding that Russell teaches that the activation system has an associated interface identification code but instead alleges, in a pre-KSR Appeal Brief, that there is insufficient motivation to combine the teachings of Hudetz, Nelson, Russell, and Wellner or to modify the teachings of Hudetz, Nelson, or Russell to arrive at activation system having an associated interface identification code. (Br. 22-25.)

Because Appellant does not even allege the Examiner erred in finding that Wellner teaches the activation system has an associated interface identification code, Appellant has not met the burden of showing that the Examiner erred. Moreover, based on our review of the record, we find that Wellner teaches that the activation system has an associated interface identification code. (FF 17-18.)

"[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." KSR, 127 S. Ct. at 1740 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)). Here, Wellner's scanner pen identification code (stored in scanner pen 11) and Hudetz and Nelson's activation system are *old elements*. Including a scanner pen identification code in Hudetz and Nelson's activation system maintains the *same functions* performed by both the scanner pen identification code and the activation system because it merely adds an identification code to the activation system for identification of the activation system. Thus, we find the proffered use of Wellner's scanner pen identification code in Hudetz and Nelson's activation system yields a

predictable result because it uniquely identifies Hudetz and Nelson's activation system.

Accordingly, we conclude that the Appellant has not shown that the Examiner erred in rejecting claims 13-15 and 31-32 under 35 U.S.C. § 103(a).

C. Rejection of claim 1 over Buckley and Schmitt

The Examiner rejects claim 1 over the combined teachings of Buckley and Schmitt. (Ans. 9-11 and 19-20.) The Examiner finds that Buckley teaches all elements of claim 1 except for a portable triggering device having a unique code stored therein and extracting the code from the triggering device with an activation system when the triggering device is proximate to the activation system. (*Id.*) The Examiner relies on Schmitt to teach the elements not taught by Buckley. (*Id.*)

Appellant alleges that Buckley does not teach an "activation system" and that the combination of teachings of Buckley and Schmitt is improper. (Br. 18-22.) Appellant does not allege that the Examiner erred in finding that the combined teachings of Buckley and Schmitt teaches all elements of claim 1 other than an activation system. (*Id.*)

Based on our review of the record, we find that the combined teachings of Buckley and Schmitt teach all elements of claim 1, including the activation system. (FF 19-27.)

We specifically address Appellant's contention that Buckley does not teach an "activation system." As we discussed *supra* with regard to the rejection of claim 1 over the combined teachings of Hudetz, Nelson, and

Russell, we broadly but reasonably construe the claimed “activation system” to at least require a transmitter and receiver capable of transmitting and receiving signals to and from a triggering device.

Claim 1 requires that the activation system extract a unique code from a portable triggering device when the portable triggering device is proximate to the activation system. Schmitt teaches a passive transponder, carried by a person, transmits the passive transponder’s authorization signal to a receiver when a transponder powering means is positioned in proximity to the passive transponder. (FF 25-27.)

Claim 1 also requires that the activation system is disposed on a network and is physically separate from the triggering device. Buckley teaches that a writing implement 16 reads and stores a bar code stored on an article. (FF 19-20.) Buckley teaches that a writing implement 16 communicates with a personal computer using a wireless link and the computer accesses a network by connecting to an Internet server. (FF 22-24.) Buckley teaches that the writing implement 16 is separated from a data well 26 and that to transfer data from writing implement 16 to data well 26, the data transfer end 20 of the writing implement 16 is inserted into a data well 26. (FF 21.) Thus, we find the combination of Buckley and Schmitt teaches an activation system that extracts a unique code from a portable triggering device when the portable triggering device is proximate to the activation system and that the activation system is disposed on a network and is physically separate from the triggering device.

We next address whether the Appellant has shown that the Examiner erred in combining the teachings of Buckley and with those of Schmitt. The



Examiner finds that Buckley suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as the wireless portable triggering device taught by Schmitt. (Ans. 10-11 and 19-20.)

Appellant alleges that the Examiner's cited portions of Buckley and Schmitt do not provide a suggestion to combine the teachings of Buckley and Schmitt. (Br. 20-22.)

We disagree. We find Appellant has not shown that the Examiner erred in combining the teachings of Schmitt with those of Buckley. Where, as here, the application claims the combination of familiar elements according to known methods, it is likely to be obvious when it does no more than yield predictable results. *KSR*, 127 S. Ct. at 1739. Because both Schmitt and Buckley teach techniques for obtaining a unique code from a portable device, a person of ordinary skill in the art would have had good reason to pursue the known options of substituting Schmitt's transponder powering means that interrogates a passive transponder to receive an identification stored by the transponder in place of Buckley's code reader that reads and transfers a unique code from an article by connection with a data well 26. It would require no more than *ordinary skill and common sense* for a system to automate the identification retrieval by using a transponder powering means and a passive transponder with a unique code in place of a system with code reader that reads an article with a unique symbol. *See KSR*, 127 S. Ct. at 1742. Both of Schmitt's and Buckley's code reader systems are coupled to a computer (FF 22 and 28). Thus, substituting Schmitt's system in place of Buckley's system would require no more than

ordinary skill and common sense. One of ordinary skill in the art would have achieved a predictable result by substituting Schmitt's system in place of Buckley's system because the functions of Schmitt's system are maintained.

Appellant has presented no evidence that giving the information retrieval system designer the choice of implementing Schmitt's transponder system in place of Buckley's code reader system was *uniquely challenging or difficult for one of ordinary skill in the art* nor has Appellant presented evidence that this *represented an unobvious step over the prior art*. See *Leapfrog*, 485 F.3d at 1162.

Accordingly, we conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1-4, 8-11, 16, 18-22, 24, 26, 28-29, 33, and 35 under 35 U.S.C. § 103(a).

#### CONCLUSIONS OF LAW

On the record before us, we conclude that:

(1) Appellant has not shown that the Examiner erred in finding claims 1-12, 16, 18-30, 33, and 35 are unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Hudetz, Nelson, and Russell;

(2) Appellant has not shown that the Examiner erred in finding claims 13-15 and 31-32 are unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Hudetz, Nelson, Russell, and Wellner;

(3) Appellant has not shown that the Examiner erred in finding claims 1-4, 8-11, 16, 18-22, 24, 26, 28-29, 33, and 35 are also unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Buckley and Schmitt; and

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(4) claims 1-16, 18-33, and 35 are not patentable.

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DECISION

The Examiner's rejection of claims 1-16, 18-33, and 35 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

APJ initials

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JPL

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